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No. 15-446

In the Supreme Court of the United States

CUOZZO SPEED TECHNOLOGIES, LLC,

Petitioner,

v

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE PAUL R. MICHEL IN SUPPORT OF NEITHER PARTY

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INTEREST OF THE AMICUS CURIAE[1]

Amicus Curiae Paul R. Michel is a retired Chief Judge of the United States Court of Appeals for the Federal Circuit, the reviewing court for essentially all patent rulings. Judge Michel has a strong interest in offering neutral, impartial advice to the Court on the Court's interpretation of patent claims so as to advance innovation, here particularly pointing out and distinctly claiming subject matter regarded as the invention, so as to avoid ambiguities. On the basis of his service on the court for over 22 years, hearing thousands of patent appeals, he may have insights of use to the Court.

SUMMARY OF THE ARGUMENT

Much of the problem with the BRI standard comes from a failure to apply it properly, and thus to unduly separate it from the *Phillips* standard for claim construction. In true application, both standards should require (a) viewing claim meaning from the perspective of a person of ordinary skill in the relevant art, and (b) using the entire patent specification to understand the claims, rather than reading the claims in isolation. If this Court emphasizes the importance of both these points—in any claim construction

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[1] No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the *amicus curiae* or his counsel made a monetary contribution to its preparation or submission. *Amicus* understands that Petitioners have consented to the filing of amicus briefs in this appeal, and amicus is awaiting a response from Respondent on consent, and will move for leave forthwith if such consent is not received.

context—it will do much to eliminate the problems of the BRI standard.

ARGUMENT

I. PATENT CLAIMS THAT DO NOT PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE INVENTION SHOULD BE REJECTED, NOT INTERPRETED BROADLY.

Congress expressly addressed patent claim language that is capable of multiple interpretations in Section 112(b) of Title 35—noting that such claim language is not permitted:

> The application shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter regarded as the invention.

35 U.S.C. §112(b); *see also* 35 U.S.C. § 112, para. 2 (pre-America Invents Act version with substantially the same language). The responsible parties for insuring that the claims define the invention with particularity include the inventors through their attorney, the patent examiner, and other patent officials responsible for reviewing the claims before allowing them to issue. Such process is meant to be "cooperative"—"[t]he days of an adversarial relationship with patent applications are over," former Patent & Trademark Office Director David J. Kappos told an audience of academics, practitioners, and Patent Office employees. 79 Patent, Trademark & Copyright J. 101 (Nov 27, 2009). In his first few months in office, Kappos said that he "had repeatedly

instructed Examiners to help applicants find patentable subject matter." *Id.*

The inventor has the power of the pen and is thus responsible for finding a way to define the invention with particularity. That means drawing, with text, the meets and bounds of the patent property, both to distinguish from the prior art and to let members of the public see clearly how to avoid trespassing on the patent property just as a land owner defines meets and bounds of a lot with a deed so the public can recognize and avoid trespassing on the property. If the property owner has a lot on Main Street, the boundaries exclude coverage of other property on Main Street. So do the patent claims avoid covering what is outside the patent claims that might include invalidating prior art.

Although patent claim drafting has been identified as one of the hardest legal tasks, it is simplified greatly by the fact that the claims do not have to stand on their own and be inherently unambiguous. Rather, the patent applicant (for pending applications) or patent owner (for issued patents) gets the benefit of their entire patent specification (both figures and text), which describes the invention in prose and at much greater length than the claims do. For example, using the analogy above, if the claim says "Main Street," the Patent Office should not be able to reject the claim merely because it fails to recite a city name that would clear up the ambiguity of *which* main street—as long as the patent specification makes clear what city's main street is to be looked to. As this Court explained in *Nautilus Inc. v. Biosig Instruments Inc.*, the specificity of a claim is to be judged with the explanations about the invention in the specification included:

> In place of the "insolubly ambiguous" standard, we hold that a patent is invalid for indefiniteness ***if its claims, read in light of the specification delineating the patent***, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

__ U.S. __, 134 S. Ct. 2120, 2124 (2014) (emphasis added). The importance of clear claim language and of the patent specification in understanding the claim language are similarly highlighted by the Patent Office's claim construction regulations, which require a connection between claim terminology and specification terminology:

> The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

37 C.F.R. § 1.75(d)(1) (setting forth the Office's general requires for patent claims). The focus on the specification in construing claims ensures that the words are understood in context, not a vacuum.

Moreover, any determination of claim scope must be performed from the perspective of a person skilled in the art of the invention. Courts and the Patent Office must both exercise caution to avoid falling into the trap of reviewing the claim limitations as would a lawyer or judge. Rather, they must discipline themselves to adopt the perspective of the skilled

artisan. Patents are necessarily at the edge of technology, and thus often at the edge of our language's ability to describe technology. And even in established technological areas, researchers have their own unique vernacular that may not match ordinary language, and perhaps even their own sense of how much uncertainty in language should be permitted—certainly the level of precision demanded by a particle physicist would likely be different from that demanded by a board game designer.

Resort to the specification when trying to understand a claim complements the approach of viewing the invention through the eyes of the skilled artisan. That is because even a skilled artisan must understand, not only the general field in which the invention is placed, but what the inventor is trying to achieve with his or her particular invention—and that is explained in the inventor's written description and figures.[2] Patent claims are complex things—trying to draw a perfect line around what is new and inventive, while carving out what is old and in the prior art. Each claim is also forced to be stated as a single English sentence, thus increasing the odds of awkward phrasing. The problems that come out of such challenges can be resolved only by obtaining a fuller understanding of the invention from the written description and figures, as viewed by a skilled artisan.

The approach of construing claims so that they receive the meaning a skilled artisan would give them in the context of the entire specification is also supposed to be used by courts for issued patents. *See*

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[2] Technically, the "specification" includes the figures, detailed description, and the claims—though judicial opinions often equate the "specification" with only the written description.

Phillips v. AWH Corp., 415 F.3d 1303, 1316-17 (Fed. Cir. 2005) (*en banc*). Thus, the putative claim construction standard between courts and the Patent Office is the same—with the one minor difference being that courts may apply disclaimers made by a patent owner during prosecution, even if the claims do not supply a textual hook for such disclaimer, while the Patent Office properly forces an applicant or Patent Owner to put the explicit text in the claims if it is not already there.

There is thus little justification in recognizing a BRI standard, if claim construction is occurring in the Patent Office the way it should. The justification is further undercut for patents that have already issued, as they come with a property right that should not be readily taken away. And that is triply so where, as a practical matter, amendments are severely restricted in post-grant proceedings, and where the expedited nature of the proceedings further undercuts efforts to clarify claims.

Because these Reviews are purely adjudicative, not examinational, such restrictions may be defensible, but they place immense pressures on any justifications for using BRI. And the use of BRI begs the question of how an issued patent can have multiple meanings or scopes in the Patent Office, but cannot in litigation under what is, ostensibly, an essentially identical test. Furthermore, the use of BRI sets up the prospect of conflicting rulings on the very same patent in view of the very same prior art—something that has occurred and will occur again. But this Court has disapproved ambiguity in patient claims, holding that it requires invalidation out of fidelity to the mandate of Section 112 for claim definiteness. In short, there is little for BRI to do

when claims are interpreted properly, and claims that remain ambiguous even when read in view of the specification through the eyes of a skilled artisan, should be rejected.

II. THE BRI STANDARD CREATES PROBLEMS IN PRACTICE THAT ARE NOT APPARENT FROM ITS THEORY

In theory, the *Phillips* standard for claim construction should seldom depart from the BRI standard, so that (again, in theory), this appeal should be relatively unimportant. Specifically, under the *Phillips* standard, courts are to apply a term's ordinary meaning as it would be understood by a person of ordinary skill in the art. *Phillips*, 415 F.3d at 1316-17. They depart from that ordinary meaning if there is a clear and unambiguous disclaimer by the applicant in the patent specification or the prosecution history. *E.g., 3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013) ("Where a disavowal does not exist, the ordinary and customary meaning of the claim term will be given its full effect."). Similarly, under BRI, the Patent Office is supposed to apply a claim term's ordinary meaning as understand by a skilled artisan, unless that ordinary meaning conflicts with the patent specification. *See Phillips*, 415 F.3d at 1316; *Trivascular, Inc. v. Samuels*, __ F.3d __, 2015 WL 463539, at *3 (Fed. Cir. Feb. 5, 2016). *But see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."). With the exception of looking to disclaimers in the prosecution history under *Phillips*, but not under BRI, these standards are basically the same—meaning there should be little to care about in this appeal.

But the Patent Office frequently does not apply this stated test for BRI—instead, using a "broadest interpretation," "broadest examiner's interpretation,"

or an interpretation that does not look to the specification for guidance. For example, in *In re Stoller*, an invention for a roll-out blanket for turf required that its layers be "laminated," and the Patent Office construed that term to only require a structure with multiple layers, however joined. Docket 2014-1271, at *2-3 (Fed. Cir. Jan. 15, 2015) (non-precedential). The Federal Circuit logically found that "laminating" requires some sort of fusing or bonding of the layers—based both on dictionary definitions (ordinary meaning) and an example in the patent that used a molten polymer to bond the layers and explained the durability benefits of lamination. Id. at *4-5. In *Microsoft Corp. v. Proxyconn, Inc.*, the Federal Circuit again held that the Board used constructions that were unreasonably broad—e.g., construing a term that required a "gateway ... connected to [a] packet-switched network in such a way that network packets sent between at least two other computers" would cover a gateway that was one of the "two other computers." 789 F.3d 1292, 1298-99 (Fed. Cir. 2015). And in *PPC Broadband, Inc. v. Corning Optical Communications RF, LLC*, the Federal Circuit found that the Board in an IPR had selected the broadest definition in a dictionary, when it should have picked a definition consistent with how the term was used throughout the patent specification. __ F.3d __, 2016 WL 692369, at *2-4 (Fed. Cir. Feb. 22, 2016).

These decisions represent just the tip of the iceberg—the few appeals decided by the Federal Circuit after a party faces a three-judge Board of Appeals and takes on the added effort of an appeal in court. Below the water line lie rejections in hundreds of thousands of pending cases at the Patent Office. It is for those cases that, in addition to deciding whether

and when BRI should apply (if at all), this Court should explain unambiguously what BRI is, or the divide between theory and practice will continue.

CONCLUSION

Amicus respectfully submits that the Court should adopt a standard for claim review that is anchored in the perspective of a person having skill in the art and that looks to the entire patent and its file history in avoiding an ambiguous construction that expands the bounds of the patent property beyond what is claimed with particularity and distinctness. If the Court does so, it will find that much, if not all, of the distinction between *Phillips* and BRI falls away.

Respectfully submitted.

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